

REMARKS

Claims 1-5 and 7-20 are pending in the present Application. Claims 9, 15, and 16 have been amended, claims 21-32 have been added, and claims 8, 12, 14, and 18-20 have been canceled, leaving claims 1-5 and 7, 9-11, 13, 15-17, and 21-32 for consideration upon entry of the present Amendment.

No new matter has been introduced by these amendments.

Antecedent basis for the amendment to claim 7 can be found at least at p. 12, paragraph [43].

Antecedent basis for the amendments to claims 9 and 16 can be found at least at p. 11, paragraph [42].

Claim 15 has been amended so that it does not depend from canceled claim 14.

Antecedent basis for new claims 21-32 can be found at least as follows.

Claim 21: Claims 1 and 6 as filed, [66], [90]

Claim 22: Example 1, [49], [51]

Claim 23: [39]

Claim 24: [39], [41]

Claim 25: [41], [66]

Claim 26: [41], [66]

Claim 27: [73]

Claim 28: [62]

Claim 29: [100]

Claim 30: Claims 1 and 6 as originally filed, [66], [90]

Claim 31: [83]

Claim 32: [83]

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-5, 7-15, 18 and 19 stand rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Randall et al. (US 2002/0155282) in view of Ali (US 4,647,486).

Claims 16 and 20 stand rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Randall et al. (US 2002/0155282) in view of Ali (US 4,647,486) and further in view of Babcock (US 4,746,365).

Claim 17 stands rejected under 35 U.S.C. § 103(a), as allegedly being obvious over Randall et al. (US 2002/0155282) in view of Ali (US 4,647,486) and in further view of Babcock et al. (US 4,746,365) and Miyakoshi (US 5,827,788).

Applicants respectfully traverse the rejections.

For an obviousness rejection to be proper, the Examiner must meet the burden, *inter alia*, of establishing that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The obviousness inquiry also requires consideration of common knowledge and common sense. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742-43 (2007); *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) ("Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense.")

Each of the foregoing rejections relies on the combination of Randall and Ali. Independent claim 1 and new claims 21-32 are not obvious over Randall et al. in view of Ali since the references, alone or in combination, fail to disclose or suggest all elements of the claim. In particular, neither reference teaches or suggests a coating having a microporosity of between 2 and 45 seconds as measured by a modified Gurley method.

The Examiner has alleged that the limitation "the coating having a microporosity, as measured by a modified Gurley method, of between 2 and 45 seconds" in the pending claims is met based on inherent teachings of the references. However, that which is inherent in the prior art, if not known at the time of the invention, cannot form a proper basis for rejecting the claimed invention as obvious under § 103. See *In re Shetty*, 566 F.2d 81, 86, 195 U.S.P.Q. 753, 756-57 (C.C.P.A. 1977). The courts have repeatedly made the distinction that "the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known.

Obviousness cannot be predicated on what is unknown." *In re Spormann*, 150 U.S.P.Q. 449, 452, (CCPA, 1966), citing *In re Adams*, 53 CCPA 996, 356 F.2d 998, 148 U.S.P.Q. 742. "Further it confuses anticipation by inherency, i.e., lack of novelty, with obviousness, which though anticipation is the epitome of obviousness, are separate and distinct concepts." *Jones et al. v. Hardy*, 220 U.S.P.Q. 1021, 1025 (CCPA, 1984) citing *In re Pearson*, 494 F.2d 1399, 181 U.S.P.Q. 641 (CCPA, 1974); *In re Oelrich*, 666 F.2d 578, 212 U.S.P.Q. 323 (CCPA, 1981). "The examiner should be aware that inherency and obviousness are distinct concepts." *Ex parte GPAC Inc.*, 29 U.S.P.Q.2d 1401, 1415, n. 15, citing *In re Naylor*, 369 F.2d 765, 152 U.S.P.Q. 106 (CCPA 1966); *In re Henderson*, 348 F.2d 550, 146 U.S.P.Q. 372 (CCPA 1965). "The theory of inherency is normally reserved for rejections under 35 U.S.C. § 102." *In re Grasselli*, 318 U.S.P.Q. 303 (Fed. Cir. 1983).

The coating microporosity is an unknown property at the time of the invention. The cited references do not disclose or suggest the specific range of microporosity of the present claims. Further, as pointed out by Mr. Rain Randall in his declaration filed on August 1, 2006, the coating microporosity has to fall within the range set forth by the present claims for achieving gypsum board properties such as bond strength (See, p. 3, paragraphs 7-8 and p. 4, paragraphs 10-11); and that the requirement for microporosity was not recognized in the cited references (See, p. 4, paragraph 11). Thus, the Examiner has used an inappropriate standard in putting forth obviousness rejections.

The alleged combination therefore fails to teach the limitation required by the claims. Thus, claims 1 and 21-32 are not obvious over Randall et al. in view of Ali. Claims 2-5, 7, 9-11, 13, and 15-17 ultimately depend from claim 1, and thus are also not obvious over the cited references.

New Claims 21-32

New claims 21-32 are further not anticipated and/or obvious over the cited references for at least the above reasons.

In sum, claims 1-5, 7, 9-11, 13, 15-17 are not obvious over the cited references, because the alleged combinations fail to teach or suggest all elements of the claims; and additionally, the Examiner has inappropriately relied on the doctrine of inherency in putting forth a rejection under 35 U.S.C. §103 (a). Further, the cited references do not anticipate new claims 21-32 or render them

obvious. The claims are allowable to Applicants. Withdrawal of the rejections is respectfully requested.

Double Patenting

Claims 1-5 and 7-20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-16, and 18-23 of co-pending Application No. 10/417,344 in view of Ali.

Claims 1-5 and 7-20 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of US 6,808,793 in view of Ali.

Applicants will file terminal disclaimers to overcome the rejections when the present claims are allowed and the '344 application has issued. As neither case has been issued or allowed, and since the claims are therefore not final in both cases, it is not possible to make any determination as to double patenting or obviousness at this time. MPEP § 804.01.I(B)(1).

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,
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